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| 09/934,777 | 08/21/2001 | Chris Kreutner | KREUTNER-38766 | 8590 |

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| EXAMINER |
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3611

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/934,777
Filing Date: August 21, 2001
Appellant(s): KREUTNER, CHRIS

Aaron T. Borrowman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 9, 2005 appealing from the Office action mailed August 13, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|-----------------|---------|
| 4,252,258 | Pummer, III | 02-1981 |
| 4,557,971 | Williams | 12-1985 |
| 5,099,991 | Kitagawa et al. | 03-1992 |
| JP110927224A | Okisawa | 04-1999 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams, U. S. Patent 4,557,971 in view of Okisawa, Japanese Patent JP411092722A.

Williams teaches self-adhereable tape comprising a pre-printed message such as "Handle with Care" or "Fragile" such that the tape serves not only to seal a carton, but also to communicate a message. Williams also teaches indicia related to the address or destination of the carton. The tape taught by Williams may be dispensed from a tape-dispensing machine (not shown) which automatically moistens the gumming layer 22 and cuts the tape to length. (See column 4, lines 7-17).

Okisawa teaches an adhesive tape 1 with repeated pre printed indicia 2 listing the rooms of a house in a side-by-side arrangement. The destination of the box in which the tape is applied is indicated by marking the already printed destination room with a circle.

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the address indicia on the tape taught by Williams with a room designations as taught by Okisawa to further define the destination of the seal carton.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U. S. Patent 5,099,991 in view of Williams and Okisawa. Kitagawa teaches a method of packing electrolytic capacitors within a box comprising the step of providing a box 18, inserting the electrolytic capacitor 14 within the box 18 of corrugated cardboard with flaps 191, 191, 192, 192. Thereafter, the flaps 191, 191, 192, 192 are closed and the box is closed by known adhesive tapes 20 to seal the box 18. (See column 3, lines 12-31). Kitagawa does not teach tape having preprinted indicia thereon. Williams teaches indicia related to the address or destination of the carton. Okisawa teaches an adhesive tape with repeated pre printed indicia 2 listing the rooms of a house in a side-by-side arrangement. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape of the package taught by Kitagawa with pre-printed address indicia as taught by Williams to provide a means to indicate the designation of the box. In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape taught by Kitagawa and Williams with repeating designation indicia as taught by Okisawa to provide a means to further define the destination of the box/package and as a

means to provide the indicia extending over the entire length of the tape so that the tape would convey the same message over the length of the tape.

With respect to claim 10-11, Williams teaches a preprinted address on the tape indicating the designation of the box and Okisawa teaches that the pre-printed designation indicia in the form of names of rooms in general houses in Japan. It would have been obvious to one having ordinary skill in the art at the time this invention was made to have any known room of a house or office printed on the tape to provide a means to identify conventional rooms associated with a house or office.

Claims 6-8 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plummer, U. S. Patent 4,252,258 in view of Williams. Plummer teaches a gang tape dispenser 10 for a multiplicity of dissimilar rolls of pressure sensitive tape 51 selectively usable at the user option. Each roll may bear repeated distinctive symbols and/or color dissimilar from those on the other rolls enabling the user to employ the strip alone or in combination for coding and/or identifying articles. Although the drawings show numeric indicia on the tape rolls, Plummer teaches that other symbols or combination of symbols may be disposed on the different tape rolls. Plummer also teaches that the rolls may be distinguished from one

another by various other means as by different colors, letters or symbols as well as by various colors of tapes imprinted with various symbols. (See column 3, lines 39-63). Plummer does not teach the different symbols on the rolls comprising the names of rooms or locations destinations.

Williams teaches self-adhereable tape comprising a pre-printed message such as "Handle with Care" or "Fragile" such that the tape serves not only to seal a carton, but also to communicate a message. Williams also teaches indicia related to the address or destination of the carton. The tape taught by Williams may be dispensed from a tape-dispensing machine (not shown) that automatically moistens the gumming layer 22 and cuts the tape to length. (See column 4, lines 7-17).

It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the tape dispenser by Plummer with the pre-printed indicia as taught by Williams to provide a means to convey the destination or room contents of the box in which the tape is applied.

With respect to claim 6, Plummer clearly teaches multiple dispensing rolls each being of a distinctive color and having distinctive indicia for identifying an article.

With respect to claims 7 and 8, Williams clearly teaches tape having pre-printed indicia related to the address or destination of the carton. The examiner contends that address or destination corresponds to the claims room indicia. It would have been obvious to print the destination address on the tape whether a street address or room addresses as a means to indicate the destination of the box or carton. In addition, since the specific legend "bedroom, bathroom, kitchen, dining room, living room, garage, storage room, office, study, den, family room, utility room etc." does not provide an unobvious functional relationship with the tape, the indicia or printed matter relating to the specific room is considered to be a design consideration. See *In re Miller*, 418, F2d 1392, 164 USPQ 46 (CCPA 969).

Claims 9, 13-16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U. S. Patent 5,099,991 in view of Plummer and Williams. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct process for packing a box taught by Kitagawa with a plurality of different tapes having different symbols and/or colors to provide a means to selectively code each box. In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the taped box by

Kitagawa and Plummer with the pre-printed indicia as taught by Williams to provide indicia related to the destination of the box after it's be packed.

(10) Response to Argument

Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive.

With respect to the rejection of claim 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Williams, U. S. Patent 4,557,971 in view of Okisawa, Japanese Patent JP411092722A, the appellant argues that Okisawa or Williams teach "away from the claimed invention as the claimed invention recites simultaneously labeling and marking a box without the need for manually marking the tape or box with a writing instruments. Specifically, the appellant argues that prior art does not teach adhesive tape with indicia repeatedly pre-printed thereon indicating a single room or location in house from which the contents of the box originated or are destined.

The examiner contends that Okisawa (secondary reference) clearly teaches repeated pre-printed indicia. (See figures 3-4). In addition, Williams (primary reference) teaches both handwriting and pre-printed indicia on the tape. In column 3, lines 33-36, Williams recites "messages such as the

company name or frequently used warning such as "Fragile" or "Handle with care" may be printed on the tape 10 so as to reduce or eliminate further marking on the carton 24". The examiner considers the address taught by Williams to corresponds to the destination of the carton or box, wherein the address can correspond the street number or *specific room within a building*. Okisawa is cited to show that adhesive tape can specifically recite a room name such a bedroom, living room, kitchen, etc. The examiner maintains that Williams teaches simultaneously labeling and marking a box without the need for manually marking the tape or box with writing instruments.

With respect to the applicant arguments that neither Williams nor Okisawa teaches a single room or location repeatedly printed on the tape. The examiner maintains that the address taught by Williams can repeatedly printed on the tape as taught by Okisawa so that the indicia will be seen over the length of the tape.

With respect to the rejections of claims 9-12 under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al., U. S. Patent 5,099,991 in view of Williams and Okisawa. The applicant argues that Kitagawa fails to teach

critical elements of the claimed invention. Specifically, Kitagawa does not overcome the shortcomings of Okisawa.

The examiner contends that claims 9-12 are drawn to the method of packing articles to be moved. Kitagawa is cited to show the claimed method step such as 1) supplying a box, 2) placing articles (capacitors) in the box, 3) closing the flaps and applying tape to seal the flaps. Williams teaches pre-printed tape with address or designation indicia thereon. Okisawa is cited to show adhesive tape with room designation pre-printed on the tape.

With respect to the rejection of claims 6-8 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Plummer, U. S. Patent 4,252,258 in view of Williams, the appellant argues that Plummer nor William discloses pre-printed indicia repeatedly on each roll or the adhesive tape along the length thereof indicating a signal room or location within a house or office. The appellant argues that the destination address does not arise to providing repeatedly pre-printed indicia on a roll of adhesive tape.

The examiner contends Plummer clearly shows, in figure 4, tape having repeated pre-printed indicia. Pummer also teaches the tape can carries symbols or a combination of symbols, wherein the symbols may be

carried by different rolls of the tape. The symbols in the form of words, such as bedroom bath, etc., are a design consideration.

Williams teaches having pre-printed address or designation printed on the tape, wherein the address can be the name or a room in a building or house.

With respect to the rejections of claims 9 and 13-16 under 35 U.S.C. 103(a) as being unpatentable over Kitagawa et al. in view of Plummer and Williams, the applicant argues that Kitagawa, Plummer or Williams teach the utilizing adhesive tape having indicia repeatedly pre-printed thereon indicating a signal room or location from which the articles were taken within a house or office or where the box or the article is destined within the house or office, and which simultaneously seals and labels the boxes without the need to mark the tape or box with a writing instrument. As stated above, Kitagawa is cited to show the claimed method step such as 1) supplying a box, 2) placing articles (capacitors) in the box, 3) closing the flaps and applying tape to seal the flaps. Plummer is cited to shows tape having repeated pre-printed indicia. Williams teaches pre-printed tape with address or designation indicia thereon.

The appellant also argues the examiner inappropriately used appellants claims as a framework from which to pick and choose among individual references, to recreate the claimed invention.

In response to the Applicant's argument that the examiner's conclusion of obviousness is bases upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in sense necessarily a reconstruction bases upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such as reconstruction is proper. *In re McLaughlin*, 443 F. 2d 1392; 170 USPQ 209 (CCPA).

The rejection is maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/934,777
Art Unit: 3611

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Respectfully submitted,



Cassandra Davis
Primary Examiner
Art Unit 3611

CD

Conferees:

LM, BG, CD

LDm BX (A)